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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ekstrom Industries, Inc.

Serial No. 76222945

William M. Hanlon, Jr. of Young & Basile, P.C. for Ekstrom Industries, Inc.

LaVerne T. Thompson, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Rogers, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 12, 2001, Ekstrom Industries, Inc.
(applicant) applied to register the mark OPTI-LOCK, in
typed form, on the Principal Register for goods currently
identified as "Lockable metal cover for an optical
communication port on an electric watthour meter" in

International Class 6.¹ The application was originally based on applicant's bona fide intention to use the mark in commerce. The mark was published for opposition on April 16, 2002. Subsequently, applicant submitted an amendment to allege dates of use anywhere and in interstate commerce of November 4, 2002.

The examining attorney (Brief at 2) has refused registration on the ground that "the display of the mark on the drawing differs from the display of the mark on the specimen" citing 37 CFR § 2.72(b). The examining attorney asserts (Brief at 3) that the "drawing displays the mark as OPTI-LOCK. The specimen displays the mark as OPTI-LOCK, which appears below the wording EKSTROM... The wording EKSTROM appears in the same type font, in the same size pitch as OPTI-LOCK. The additional wording appears in such close proximity to the proposed mark it creates the commercial impression that the mark is unitary. That is two elements th[at] come together to create a whole mark."

¹ Serial No. 76222945. At the time the application was published for opposition, the goods were identified as a "Lockable non-metal cover for an optical communication port on an electric watt-hour meter" in International Class 17. After publication, applicant called to the examining attorney's attention an amendment that had changed the goods from "non-metal" to "metal." The examining attorney (Brief at 2 n.1) noted that on "July 25, 2003[,]" the applicant submitted an amendment to change the classification and the identification of goods, which has been accepted. Pending the disposition of the appeal, the application will be republished in the amended class."

Applicant responds by arguing (Reply Brief at 1) that the "mark is not physically connected by lines or other design features. The actual goods are small and the Applicant's corporate name (Ekstrom) is on the goods above the marks as a further source identifier of the goods."

We begin our discussion by focusing on a comparison of the mark in the drawing and the specimens. The drawing consists of the term OPTI-LOCK in typed form. The specimens show the mark applied to the goods themselves approximately in the manner shown below:

EKSTROM
OPTI-LOCK
DO NOT REMOVE
PAT. PEND.

USPTO rules (37 CFR § 2.51(b)) require:

In an application under section 1(b) of the Act, the drawing of the mark must be a substantially exact representation of the mark as intended to be used on or in connection with the goods and/or services specified in the application, and once an amendment to allege use under §2.76 or a statement of use under §2.88 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.

The examining attorney's position (Brief at 5) is that the "removal of EKSTROM from the mark is an incomplete representation of the mark, essentially a mutilation of the mark as it appears on the drawing."

"'Mutilation' is a concept long recognized as a part of trademark registration case law." Institut National des Appellations D'Origine v. Vintners International Co., 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992). In cases of an alleged "mutilation" of the mark, the "determinative factor is whether or not the subject matter in question makes a separate and distinct commercial impression apart from the other element(s)." TMEP § 807.14(b) (3rd ed. May 2003). See also Institut National, 22 USPQ2d at 1197. The question of whether a mark is a mutilation "boils down to a judgment as to whether that designation for which registration is sought comprises a separate and distinct 'trademark' in and of itself." Id. TMEP § 807.14(b) informs examining attorneys that:

[I]n an application under § 1 of the Trademark Act, the applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. An applicant may apply to register any element of a composite mark used or intended to be used if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.

Cases have frequently held that an applicant's use of its corporate name or house mark along with another trademark does not create a unitary mark. See, e.g., In re Servel, Inc., 181 F.2d 192, 85 USPQ 257, 260 (CCPA 1950)

("The courts in a proper case may recognize the right to registration of one part of an owner's mark consisting of two parts." SERVEL functions as a mark apart from the term INKLINGS); Textron Inc. v. Cardinal Engineering Corp., 164 USPQ 397, 399 (TTAB 1969) ("While the record does show that Textron's principal or house mark 'HOMELITE' appears on its chain saws as well as in all of its advertising literature, there is no statutory limitation on the number of trademarks that one may use on or in connection with a particular product to indicate origin"); In re Emco, Inc., 158 USPQ 622, 623 (TTAB 1968) ("It is concluded that the law and the record support applicant's position that 'RESPONSER' is registrable without addition of the surname 'MEYER'"); and In re Barry Wright Corp., 155 USPQ 671, 672 (TTAB 1967) ("[I]t is clear that the notation '8-48' stands out as a distinguishable element separate and apart from the statement 'ANOTHER 8-48 FROM MATHATRONICS'").

Even when terms have been physically joined in the specimens, case law recognizes that these terms can be separately registered if the evidence of record indicates that they will be recognized as distinct trademarks. See In re Raychem Corp., 12 USPQ2d 1399, 1400 (TTAB 1989) (Board held that the "fact that hyphens connect both the part number and the generic term to the mark does not,

under the circumstances presented by this case, create a unitary expression such that 'TINEL-LOCK' has no significance by itself as a trademark"); In re Berg Electronics, Inc., 163 USPQ 487 (TTAB 1969) (GRIPLET creates a separate commercial impression despite overlapping with house mark BERG); In re Dempster Brothers, Inc., 132 USPQ 300 (TTAB 1961) (Despite specimens showing the terms DEMPSTER DUMPMASER sharing the same first and last letters, DUMPMASER separately registrable).

In this case, applicant correctly describes its goods as "small." Indeed, the printed material set out previously takes up the great majority of the space on the goods. While the examining attorney relies on the fact that the term OPTI-LOCK is in "close proximity" to the corporate name EKSTROM, it would be difficult to display them otherwise on goods of this small size. In addition, mere proximity "does not endow the whole with a single, integrated, and distinct commercial impression." Dena Corp. v. Belvedere International Inc., 960 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). While the term OPTI-LOCK does appear below applicant's corporate name or house mark EKSTROM, the terms are physically separated on two different lines. This point would seem to favor the marks creating a separate rather than a unitary impression. Id.

Furthermore, while the examining attorney notes that the words EKSTROM and OPTI-LOCK are in the same type font and style, it is also true that the display is a simple block style that is only marginally bigger and thicker than the other printed matter on the goods. In addition, while the terms share a type style, this simple style would hardly be noticed.

Another point the examining attorney makes (Brief at 4) is that "the wording EKSTROM OPTI-LOCK has no meaning other than trademark significance." According to the examining attorney (Brief at 5), EKSTROM "appears to be a surname." OPTI-LOCK appears to have some suggestive meaning when used with a "lockable metal cover for an optical communication port." There is nothing unusual about using more than one trademark on a product. Textron, 164 USPQ at 399 ("[J]udicial notice may be taken of the fact that it is a common practice for manufacturers to apply both a house mark and a product mark to their various items of merchandise"). While the terms EKSTROM and OPTI-LOCK have trademark significance, there is nothing in their meanings that unites them. Thus, there is no reason to assume that prospective purchasers would view the terms here as a unitary mark as opposed to two separate marks.

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Therefore, we conclude that the term OPTI-LOCK, as used on the specimen, creates a commercial impression separate and apart from the mark EKSTROM.

Decision: The refusal to register is reversed.